UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,576	01/21/2000	William J. Baer	STL000013US1	6006

23373	7590	05/05/2005

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EXAMINER
NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/489,576	BAER ET AL.
	Examiner	**Art Unit**	
	Paul Nguyen-Ba	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 April 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 4/11/2005 has been entered.

2.   Claims 1-51 are currently pending. Claims 1, 6, 16, 21, 31, and 36 are independent

claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw-

Hill Primis Custom Publishing ("McGraw") (www.mhhe.com/primis), archived circa 1998, via

the Wayback Machine (www.archive.org), in view of Helmick et al. ("Helmick"), U.S. Patent

No. 6,470,171.

Independent Claims 1, 6, 16, 21, 31, 36 and

Dependent Claims 4, 11, 19, 26, 34, 41, 49, 50, 51

McGraw teaches a method, system, and a program storage device readable by a machine

for creating custom published textbooks (*compare with* "books") corresponding to the each

particular user's needs, teaching technique, style, **content**, and **organization** (see pg. 1).

Primis database (*compare with* "data repository") is a custom publishing database that

contains a collection of modular, stand-alone text files (*compare with* "second plurality of

content entities of a second hierarchically structured content object") (see pg. 3 → includes

textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works,

and historical documents each structured such that the content entities rank or grade in a

subordinate manner in a "hierarchy;" see pgs. 5-12 → i.e. discipline, volume, chapter, section,

etc.) that can be mixed and matched *in any order* (*compare* with "at a location determined by

user") and seamlessly arranged to create a custom book (*compare with* "first hierarchically

structured content object") consisting of the selected modular text files (*compare with* "first

plurality of content entities") (see pg. 3).

Each of the "content entities" of the first and second objects has identifiers (see pgs. 5-9,

and 12 → each content identity is identified by a unique title or name, a unique URL, and a

unique Item Identifier number).

McGraw does not specifically show defining the first object by a first list of content

entity identifiers *organized as an outline of containers such that adding the content entity*

identifier of one of the second plurality of content entities to the first list outline adds the

identified content entity to the first content object at a location determined by a user.

However, McGraw teaches an "Add" hyperlink corresponding to each second object

identifier (see pgs. 7,9, and 12) for the purpose of adding the content entities of a second object

to a first object. McGraw further teaches a "Review" hyperlink for the purpose of reviewing the

contents of the first object of the custom publishing process. Furthermore, Helmick teaches an

on-line educational system for display of educational materials wherein a user can use a course

manager screen in order to build an electronic syllabus (see Figs. 3V-3X). Fig. 3X specifically

teaches an add content screen used to add or modify content for particular identified units of a

course and thus build a syllabus in a tree/outline form for said course (see col. 25 lines 8-58).

It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to modify the teaching of McGraw with the teachings of Helmick to

include defining the first object by a first list of content entity identifiers organized as an outline

of containers such that adding the content entity identifier of one of the second plurality of

content entities to the first list outline adds the identified content entity to the first content object

at a location determined by a user for the motivational purpose of building a custom hierarchical

outline compilation of educational materials.

Claims 2, 7, 17, 22, 32, 37

McGraw further teaches *defining the second object by a second outline of containers* (pgs. 3, 7, 9, and 12 → the available textbooks are defined in hierarchical outline form (collection of modular text files that can be mixed and matched) → book containers, chapter containers, etc.) or *list of content entity identifiers* (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number).

Claims 3, 8, 18, 23, 33, 38

McGraw further teaches the method, system, and a program storage device readable by a machine wherein *adding an entity identifier from the second list or second outline container to the first list adds the identified content entity to the first object* (pgs. 7, 9, 12 → the "Add" hyperlink adds the second list or outline to the customized textbook, as discussed above).

Claims 5, 13, 14, 20, 28, 29, 35, 43, 44

McGraw further teaches a *user interface communicating with the data repository* (pgs. 5-12 → i.e. Website browser communicating with Primis database), and *providing a mechanism for selecting a content entity identifier or a container from the second list or second outline to add to a desired location in the first list through the user interface* (pgs. 7, 9, 12 → the "Add" hyperlink adds the second list or outline to a specified location in the customized textbook, as discussed above).

Claims 9, 24, 39

McGraw further teaches the method, system, and a program storage device readable by a machine wherein *a first container in the second outline contains on or more containers* (pgs. 3, 5-12 → "disciplines container" contains "book containers" which further contains "chapter containers" which further contain "section containers," etc.).

Claims 12, 27, 42

McGraw further teaches the method, system, and a program storage device readable by a machine wherein *the first and second objects are books* (pgs. 6, 8, 10) and the *containers are one or more of a book, volume, and a chapter* (pgs 7, 9, 12).

Claims 15, 30, 45

McGraw further teaches *a user interface communicating with the data repository*, and *providing a mechanism for creating a new container to add to the first outline at a desired location through the user interface* (pg. 3 → allows instructors to add their own created syllabus to the first outline at a desired location by uploading it through the user interface).

Claims 10, 25, 40

McGraw teaches a method, system, and a program storage device readable by a machine as explained with respect to claims 6, 7, and 9 above, but does not specifically teach the method, system, and the program storage device readable by a machine wherein adding the first container

to the first outline adds the content entities identified by the content entity identifiers of *all*

containers in the first container to the first object.

McGraw teaches the outlining of textbooks into containers for the purpose of increasing

the modularity of files for ease in creating a mixed and matched customized book (pgs. 3, 7, 9,

12).

It was commonly known to those of ordinary skill in the art that in hierarchical outlines

each level is subordinate to the one above. Therefore, it would have been obvious at the time the

invention was made to a person having ordinary skill in the art to modify the teachings of

McGraw to add the content entities identified, as well as all of the content entities' dependents

(i.e. full containers), in the first container object for the purpose of increasing the modularity of

files for ease in creating a mixed and matched customized book.

Claims 46-48

McGraw teaches the method, program storage device, and system wherein said first list

of content identity identifiers defining the first object comprises content identity identifier names

(see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique

URL, and a unique Item Identifier number), but does not specifically teach the content identity

identifier names being defined by the user.

However, McGraw teaches the compilation of a custom textbook using the instructor's

own content and materials (see pgs. 1 and 3 – 2nd paragraph) for the purpose of customizing the

textbook to the instructor's own personal preferences. It was commonly known to those of

ordinary skill in the art that an instructor can define his own work's content entity identifier for

the purpose of customizing the final textbook to the instructor's own personal preferences.

Therefore, it would have been obvious at the time the invention was made to a person

having ordinary skill in the art to allow an instructor to define his own work's content entity

identifier for the purpose of customizing the final textbook to the instructor's own personal

preferences.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-51 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

6.   The prior art made of record on form PTO-892 and not relied upon is considered pertinent

to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these

references fully when responding to this action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094.

The examiner can normally be reached on 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

SANJIV SHAH
PRIMARY EXAMINER